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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/709,131

11/10/2000

Ronald B. Gartenhaus

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BUFFALO, NY 14202-4040

EXAMINER

SANG, HONG

ART UNIT

PAPER NUMBER

1643

MAIL DATE

DELIVERY MODE

02/05/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/709,131	GARTENHAUS, RONALD B.	
	<b>Examiner</b>	<b>Art Unit</b>	
	HONG SANG	1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 32, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **RE: Gartenhaus**

1. Applicant's response filed on 10/22/2009 is acknowledged. Claims 32, 36 and 37 are pending. Claims 1-31, 33-35 and 38-48 have been cancelled.
2. Claims 32, 36, and 37 are under examination.

### ***Rejections Withdrawn***

3. The rejection of claims 32, 36 and 37 under 35 U.S.C. 103(a) as being unpatentable over Prosniak et al. (Cancer Res., 1998, Oct., 58:4233-4237), in view of Young et al. (US 6,153,740, Date of Patent: 11/28/2000, earliest effective filing date at least 2/13/1997) is withdrawn in view of applicant's submission of 37 C.F.R. §1.132 Declaration showing that the Prosniak's reference discloses inventor's own work.

### ***Rejections Maintained***

4. The rejection of claims 32, 36 and 37 under 35 U.S.C. 102(e) as being anticipated by Edwards et al. (US 6,783,961B1, Date of Patent: 8/31/2004, earliest effective filing date: 2/26/1999) is maintained.

The response states that the priority should be accorded to the filing date of the provisional for the pending claims. The response states that the publication date of Dr. Gartenhaus' work per the Prosniak et al. reference is October 1, 2008. Prosniak et al. reference in Fig. 1 discloses an amino acid sequence that is 100% identical to SEQ ID NO:8. Thus, the Prosniak et al. reference itself establishes that Dr. Gartenhaus was in

possession of SEQ ID NO:8 at least as early as October 1, 2008, which is before the 102(e) date of the Edwards et al. reference.

Applicant's arguments have been carefully considered but are not persuasive. As indicated in the previous office action, if applicant believes that support for the claims is present in the earliest filed priority document, applicant must, in responding to this action, point out with particularity, where such support may be found (see office action mailed on 6/23/09, page 3). However, applicant's failed to point out such support. As such the decision that the pending claims are not entitled to the filing date of the provisional application is maintained. Applicant's arguments that the Prosniak reference itself establishes that Dr. Gartenhaus was in possession of SEQ ID NO:8 at least as early as October 1, 2008, which is before the 102(e) date of the Edwards et al. reference, are not persuasive because the instant claims are drawn to an antibody of SEQ ID NO:8. Furthermore, according to MPEP 706.02(b), in order to show prior invention, applicants are required to file an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent or a U.S. patent application publication claiming the same patentable invention as defined in 37 CFR 41.203(a). See MPEP §715 for more information on 37 CFR 1.131 affidavits.

### ***Conclusion***

5. No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HONG SANG whose telephone number is (571)272-8145. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry R. Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hong Sang/  
Examiner, Art Unit 1643

/Christopher H Yaen/  
Primary Examiner, Art Unit 1643